



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,171	12/08/2000	Yoshifumi Tanimoto	81800.0142	2358

26021 7590 02/07/2005

HOGAN & HARTSON L.L.P.  
500 S. GRAND AVENUE  
SUITE 1900  
LOS ANGELES, CA 90071-2611

EXAMINER

LETT, THOMAS J

ART UNIT	PAPER NUMBER
----------	--------------

2626

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/733,171	TANIMOTO, YOSHIFUMI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas J. Lett	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15-20 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: the phrase "a delivery condition storage for a plurality of registering delivery conditions ..." should read "a delivery condition storage for registering a plurality of delivery conditions ...". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Denker (US Patent 6,404,513 B1).

With respect to claim 15, Denker discloses a machine (fax machine 19, see Fig.

1) comprising:

means for receiving data (a fax interface 18, col. 2, lines 61-63) from a first device (sending fax machine 10) over a first network (PSTN 14) together with delivery information or instructions (distribution list provided to computer 16, col. 4, line 53);

means (lines 20, 24A, 24B, see Fig. 1) for preparing a list of one or more recipients (message is forwarded to one or more recipients based on a distribution list, col. 4, lines 50-53) to whom the received data will be transferred from the first device (sending fax machine 10) over the first network (PSTN 14) or another network based, at least in part, on the delivery information or instructions in the received data (distribution list provided to computer 16, col. 4, line 53);

means (fax machine 19) for transferring the data to a second device (receiving fax machine 22A) if the delivery information or instructions (distribution list provided to computer 16, col. 4, line 53) match at least one of a plurality of predetermined conditions.

With respect to claim 16, Denker discloses that the first network includes at least one of PSTN (PSTN 14, see Fig. 1), LAN and internet, and the data is facsimile image data.

With respect to claim 17, Denker discloses that the data is transferred to the second device (receiving fax machine 22A) over at least one of PSTN (PSTN 14, see Fig. 1), LAN and internet.

With respect to claim 18, Denker discloses that the predetermined conditions include day and time of data transfer (the forwarding step may include a scheduled transmission (scheduled for a particular date and time by the sender), col. 4, lines 50-55).

With respect to claim 19, the second device (receiving fax machine 22A) is a printer (machine 22A is capable of printing) associated with the machine or connected to LAN or internet.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denker (US Patent 6,404,513 B1) in view of Matsueda et al (US Patent 6,301,016 B1). Denker does not disclose expressly that the data is transferred to a printer if data transfer fails. Matsueda et al discloses a facsimile apparatus 101 capable of receiving facsimile information from communication line 102 (e.g., a PSTN network) where in the event of a failure or insufficient memory, the image data (including a print image data file) is continued by transferring the image data from the data processing apparatus to another apparatus also connected to the LAN (col 4, lines 31-39). Denker and Matsueda et al are analogous art because they are from the similar problem solving area of data transmission. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the data transfer feature of Matsueda et al to the fax machine 19 of Denker in order to obtain a way to transfer data in case of network trouble. The motivation for doing so would be to ensure delivery of information.

***Allowable Subject Matter***

4. Claims 1-14 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter: the Applicant responds to the rejection of the claim 1 by amending said claim. Claim 1 of the current application teaches similar subject matter as the prior art of Okada (US Patent 5,757,510). However, claims 1-7 are allowed for the reasons pointed out by Applicant's remarks (p8, 2<sup>nd</sup> paragraph).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, DC 20231

**or Faxed to:**

Application/Control Number: 09/733,171

Page 6

Art Unit: 2626

(703) 872-9314 (for Technology Center 2600 only).

**Hand-delivered** responses should be brought to:

Crystal Park II

2121 Crystal Drive

Arlington, VA

Sixth Floor (Receptionist).

*KA Williams*

**KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER**

TJL